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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,262	02/26/2002	Deborah Nicole Nas	01638/RPM	1304

1933 7590 05/24/2004

FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
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NEW YORK, NY 10017-2023

EXAMINER

RAMPURIA, SHARAD K

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 05/24/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,262

Applicant(s)

NAS ET AL.

Examiner

Sharad Rampuria

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

DETAILED ACTION

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rune, Chambers, Syed et al., Siddiqui et al. Weber et al.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-2 are rejected under 35 U.S.C. 102 (e) as being anticipated by Chambers.

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1. Regarding claim 1, Chambers disclosed Communications system, comprising several communications networks (9, 6, 8; fig.1; col.4; 14-26), and roaming means for facilitating roaming to users on said several communications networks (col.5; 50-61), CHARACTERIED IN THAT the roaming means are formed by a worldwide communications network (SCN) (SAN 1-3; fig.1), which is in connection with each of said several communications networks (PLMN, PSTN). (6,9; fig.1)

2. Regarding claim 2, Chambers disclosed Communications system according to claim 1, CHARACTERIED IN THAT the roaming means are formed by the earth portion (LES 1; fig.2) of a worldwide satellite-communications network (SCN), which is in connection with each of said several communications networks (PLMN, PSTN). (col.5; 22-40 & col.8; 40-53)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3-5, are rejected under 35 U.S.C. 103(a) as being unpatentable over Chambers, as applied in claim 1, further in view of Lee.

3. Regarding claim 3, Chambers disclosed all the particulars of the claim except a code (VNO) and enters it, under control of a control module (CTR), into a register (VCR), the worldwide communications network, under control of the control module. However, Lee teaches in an analogous art, that Communications system according to claim 1, CHARACTERIED IN THAT the worldwide communications network (SCN) assigns, to each of said several communications networks (PLMN, PSTN), a code (VNO) (NDC; col.5; 41-67) and enters it, under control of a control module (CTR) (col.6; 1-39), into a register (VCR), the worldwide communications network, under control of the control module, realising mutual roaming facilities to subscribers of each of said communications networks entered into the register. (col.6; 43-63) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include a code (VNO) and enters it, under control of a control module (CTR), into a register (VCR), the worldwide communications network, under control of the control module in order to support the international automatic roaming.

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4. Regarding claim 4, Chambers disclosed all the particulars of the claim except a code (VNO) among them which corresponds to the code entered into the register (VCR). However, Lee teaches in an analogous art, that Communications system according to claim 3, CHARACTERISED IN THAT terminals of the subscribers to the communications networks (PLMN, PSTN) comprise an identification module (SIM) (26; fig.6) for reading in and passing on, to the communications system, identification codes (IMSI), (col.8; 14-28) a code (VNO) (NDC; col.5; 41-67) among them which corresponds to the code entered into the register (VCR). (col.6; 43-63) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include a code (VNO) among them which corresponds to the code entered into the register (VCR) in order to support the international automatic roaming.

5. Regarding claim 5, Chambers disclosed Communications system according to claim 3, CHARACTERISED IN THAT the worldwide communications network (SCN) determines the location of a roaming user on a wireline network (PSTN) (PSTN 6; col.8; 40-53) on the basis of the A-number (IMSI; col.8; 1-5 & 17-28) of the terminal to which the terminal on the network is connected. (col.9; 52-67)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharad Rampuria whose telephone number is 703-308-4736. The examiner can normally be reached on Mon-Fri. (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703-308-5318. The fax phone numbers for the

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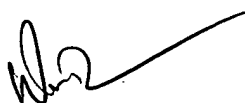
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organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Sharad Rampuria
May 17, 2004



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600